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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,748	03/15/2002	Thomas R. Mallen	1190.322US2	9163

21186 7590 03.28.2003

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,748

Applicant(s)

MALLIN

Examiner

LOVERING

Group Art Unit

1712

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on MAR 15, 2002

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 22, 23 AND 28-45 is/are pending in the application.

Of the above claim(s) is/are withdrawn from consideration.

Claim(s) is/are allowed.

☒ Claim(s) 22, 23 AND 28-45 is/are rejected.

Claim(s) is/are objected to.

Claim(s) are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved ☐ disapproved ☐.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some ☐ None ☐ of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 10/099,748 Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22, 28-33 and 37-42 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Chutko et al. 5,527,840, esp. Examples 8-31 referring to Examples 1-7, with reference to column 4, lines 58-65 for the molecular weight and acid number of patentees' carboxy addition polymer and to column 5, lines 1-9 for its glass transition temperature.

4. Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chutko et al. above in view of Martino et al. 5,567,781. The Chutko et al. reference applies as indicated in

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the preceding paragraph. While Chutko et al. do not disclose the use of an epoxy resin in which an aromatic acid, such as terephthalic or isophthalic, is used in the manufacture thereof, it would have been obvious to one skilled in the art at the time applicant's invention was made to incorporate such an epoxy resin disclosed by Martino et al. (Example 2 referring to Example 1) in the coating compositions of Chutko et al. (used in their method of coating a metal substrate) to realize the advantage of improved craze resistance made apparent by Martino et al. (column 2, lines 30-40).

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23, 28, 29, 35, 36, 38, 40 and 43-44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 28 and 38 are substantial duplicates, each of the other;

b) claims 29 and 40 are substantial duplicates, each of the other;

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c) claims 35 and 36 are indefinite in lacking antecedent basis in claim 22 (upon which they depend) for "the polyvinyl alcohol-containing phenolic resol resin" and "the resol resin", resp. [claims 35 and 36 should be rendered dependent upon claim 23.]; and

d) claims 23 and 43-45 are indefinite and incomplete and fail to properly point out the invention in not stating after "substrate" in step d) (as they should) --such that the coating cures to form a cured film on the substrate surface--.

7. Claims 23 and 43-45 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the composite material of claims 23 and 43-45 herein.

9. Applicant should insert the status of the parent case (now U.S. Patent No. 6,359,062) in the sentence inserted on page 1 of the specification by the pre-amendment filed March 15, 2002.

10. The remaining references listed on the attached Forms PTO-1449 (three sheets from parent case) and Forms PTO-892 (one copy from parent case and one new herein) are cumulative to the references applied herein, and/or further show the state of the art.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
March 20, 2003

ROBERT S. LOVERING
PRIMARY EXAMINER
GROUP ~~1712~~ 1700